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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,718	11/04/2003	In-Soo Jung	38841.00002.UTL1	7402
7590	11/29/2005			EXAMINER
Paul, Hastings, Janofsky & Walker LLP P.O. Box 919092 San Diego, CA 92130			KYLE, MICHAEL J	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/701,718	JUNG, IN-SOO
	Examiner	Art Unit
	Michael J. Kyle	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4-7, 10-12, 14-17, 20-22, 25-29, 31-34, 37-39, and 42-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (U.S. Patent Application Publication 2002/0095745) in view of Pickles (U.S. Patent No. 1,031,024).

3. With respect to claims 1, 11, 27, 28, and 44, Wang discloses a telescoping handle having an external segment (30) with a hole (35) configured to receive a locking pin (22). The telescoping handle also includes an inner segment (20) with the locking pin (22). Wang discloses a plurality of telescoping handles, which are part of a transporting device. Wang does not disclose the reinforcing mechanism as claimed.

4. Pickles teaches a material with a hole, where the hole includes a reinforcement mechanism (12, 20). The reinforcing mechanism and hole receive a member. The reinforcement mechanism prevents the material from being damaged by member received in the hole. The reinforcing mechanism inherently distributes forces imparted by a member passing through it. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wang as taught by Pickles, such that a reinforcement mechanism is included in the holes (35) of Wang, to prevent damage to the tube, or external member. One having ordinary skill in

the art would also recognize when implementing the reinforcing mechanism into Wang, that it be sized and shaped to accommodate the locking pin of Wang, so that the reinforcing mechanism can serve its intended purpose.

5. With respect to claims 2, 12, and 29, Pickles teaches the reinforcing mechanism to comprise an eyelet.

6. With respect to claims 4, 14, and 31, the combination of Wang and Pickles teaches the external segment (30 of Wang) to have an internal surface (inner surface of 10 of Pickles) comprising a recess (see Pickles figure 2). The reinforcing mechanism (12, 20, of Pickles) resides flush with the internal surface (at 14).

7. With respect to claims 5, 15, and 32, the combination of Wang and Pickles shows the external segment (30 of Wang) to have an internal surface (internal surface of 10 of Pickles) comprising a recess (see Pickles figure 2). The reinforcing mechanism (12, 20) resides below, or radially within the internal surface of the external segment.

8. With respect to claims 6, 16, and 33, the combination of Wang and Pickles teaches the reinforcing mechanism to comprise a height selected to aid the distribution of forces imparted by the locking pin.

9. With respect to claims 7, 17, and 34, Pickles teaches the reinforcing mechanism (12, 20) to be of a second, stronger, material than the first material of the external segment (10).

10. With respect to claims 10, 26, and 43, the combination of Wang and Pickles teaches a plurality of holes (25 of Wang) and a reinforcing mechanism for each hole.

11. With respect to claims 20 and 37, Wang discloses the inner segment (20) to slide within the external segment (30) between an extended and collapsed position.

12. With respect to claims 21 and 38, Wang discloses the locking pin (22) is configured to engage the hole when the inner segment is in the extended position (at upper most hole 35)
13. With respect to claims 22 and 39, Wang discloses the locking pin is configured to engage the hole (22) when the inner segment is in the collapsed position (lower most hole 35)
14. With respect to claims 25 and 42, Wang discloses an engagement mechanism "actuators" configured to allow the locking pin to be engaged and disengaged from the hole
15. Claims 8, 18, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Pickles as applied to claims 7, 17, and 34 above, and further in view of Byington (U.S. Patent No. 5,984,064). Wang is silent in regards the material the external segment is made from. Byington teaches an extensible handle for a piece luggage having external segments (25, 25') made of aluminum. Aluminum is desirable for weight considerations. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the external segment of Wang from aluminum for weight considerations. It is desirable to make luggage of a lighter weight so that it may be more easily transported.
16. Claims 9, 19, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Pickles as applied to claims 7, 17, and 34 above, and further in view of Cheraso et al ("Cheraso", U.S. Patent No. 6,125,513). Pickles teaches the reinforcing mechanism to be made from sheet metal but does not specify stainless steel (page 2, lines 105-110). Cheraso teaches a mechanism where a metal component (16) is made from "sheet metal, typically stainless steel" (column 3, line 5). From this, it is clear that one having ordinary skill in the art

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would recognize that stainless steel is suitable when manufacturing items from sheet metal. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the reinforcing mechanism of Pickles from stainless steel.

17. Claims 23, 24, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of pickles as applied to claims 11 and 28 above, and further in view of Friday (U.S. Patent No. 5,690,217). The combination of Wang and Pickles are silent regarding the composition of the locking pin. Friday teaches an extensible handle (60) with apertures (65, 67) that receive a pin (75) of a locking mechanism (74) to secure the handle in a desired position. The handle member (60) with apertures (65, 67) is analogous to the external segment of the claims. The pin (75) is made of stainless steel, and the handle member, or external segment, is made from plastics. Therefore, the locking pin (75) is made from a stronger material than the external segment. Such a configuration guards against deformation or damage to locking pin, which would harm the integrity of the mechanism. It would have been obvious to one having ordinary skill in the art at the time of the invention to construct the external segment and locking pin from the materials taught by Friday, in order to guard against deformation or damage to the locking pin.

18. Claims 1-3, 11-13, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of White (U.S. Patent No. 2,583,719). With respect to claims 1, 11, and 28, Wang discloses a telescoping handle having an external segment (30) with a hole (35) configured to receive a locking pin (22). The telescoping handle also includes an inner segment (20) with

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the locking pin (22). Wang discloses a plurality of telescoping handles, which are part of a transporting device. Wang does not disclose the reinforcing mechanism as claimed.

19. White teaches a material with a hole, where the hole includes a reinforcement mechanism (1). The reinforcing mechanism and hole receive a member. The reinforcement mechanism prevents the material from being damaged by member received in the hole. The reinforcing mechanism inherently distributes forces imparted by a member passing through it. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wang as taught by White, such that a reinforcement mechanism is included in the holes (35) of Wang, to prevent damage to the tube, or external member.

20. With respect to claims 2, 12, and 29, White teaches the reinforcing mechanism to comprise an eyelet.

21. With respect to claims 3, 13, and 30, White teaches the reinforcing mechanism to comprise a washer (W).

Response to Arguments

22. Applicant's arguments filed September 19, 2005, have been fully considered but they are not persuasive.

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23. Applicant argues the combination of Wang and Pickles fails to show a reinforcing mechanism sized and shaped to receive a locking pin. Examiner respectfully disagrees. Wang teaches an arrangement where a locking pin is received through a hole an external segment. Pickles teaches a washer placed in a hole in an article. This washer is known to have a reinforcing effect around the hole, and prevent damage to the article from any element passing through the hole. One looking to reinforce a hole through which an element passes would look to the teachings of Pickle. Additionally, one of ordinary skill in the art would recognize that the reinforcing mechanism must be sized and shaped to receive an element, in order for the reinforcing mechanism to serve its purpose. This result would flow naturally from the combination of the references.

24. Applicant argues that since Wang does not recognize the need for a reinforcing mechanism, one would not have motivation to combine with the teachings of another reference. Examiner notes that motivation to combine can also be found in the teaching reference or in the knowledge generally available to one of ordinary skill in the art. From Pickles, it is seen that a washer reinforces the hole. One having ordinary skill in the art would recognize the advantages of reinforcing a hole, and apply them to other situations where an element passes through a hole.

25. Applicant argues that there is no motivation to combine the teachings of Cheraso with Wang and Pickles. Examiner respectfully disagrees. Cheraso shows equivalence between the claimed material and the material used in Pickles. One of ordinary skill in the art would recognize that either material may be used to obtain substantially the same result.

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26. Applicant argues that Wang, Pickles and Friday fail to show a reinforcing mechanism sized and shaped to receive the locking pin. This has been addressed above in the discussion of the combination of Wang and Pickles. It is also noted that the limitation "to distribute forces imparted by the locking pin" is a functional limitation. In that Wang and Pickles disclose all of the claimed structure associated with this function, the combination of Wang and Pickles is considered capable of performing the claimed function.

27. Applicant argues the Friday never teaches or suggests that the pin member material must be stronger than the handle member material. Examiner respectfully disagrees. As discussed in the body of the rejection above, Friday teaches the locking pin to be made of stainless steel and the handle member to be made of plastics. Stainless steel is stronger than plastic, and thus meets the limitation of the claim.

28. Applicant argues that in the combination of Wang and White, that the grommet of White would not be sized and shaped to receive a locking pin. A similar argument has been addressed above, regarding the combination of Wang and Pickles. Examiner adds that changing the size or shape of a known member to accommodate an item is within the level of one having ordinary skill in the art. In this case, one having ordinary skill in the art would recognize the grommet of White to provide reinforcing benefits to a hole through which an element passes. Changing the size and shape of the grommet would not produce a new or unexpected result.

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


ROBERT J. SANDY
PRIMARY EXAMINER